

Docket No. F-9200

Ser. No. 10/590,253

REMARKS

Claim 9 is now pending in this application. Claims 1-8 are rejected. Claims 1-8 are cancelled herein. New claim 9 is added.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by the JP 2003-314541 ('541) reference. Applicant herein respectfully traverses these rejections. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

Claims 1-8 are now cancelled rendering the rejections moot. However, insofar as the subject matter of new claim 9 reflects that of the cancelled claims and in the event the Examiner considers asserting the present rejection against the new claims, applicants submit the following remarks.

Claim 9 is directed to a method of imparting a preload to an oblique contact double row ball bearing. The claim relates imparting the preload through the measurement of rotation torque in a state where only the small-diameter-side row of balls of the first bearing (first bearing second row) with a smaller clearance and the large diameter side row of balls of the second bearing (second bearing second

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row of balls) first fitted to their respective raceways prior to the fitting of the remaining rows of balls (first bearing first row of balls and second bearing second row of balls). This sequentially fitting of the balls in the bearings, by applying the preload, allows for easier preload adjustment by adjusting the preload by measuring the resultant torque generation of the sequentially fittings. When measuring rotation torque with only one side row of balls in contact with the raceway surface, the contact pressure of the raceway surface and the balls increases while rotation torque increases at a lesser rate and thus a result a wider adjustment range of torque can be obtained. This is specifically related in the specification at pages 18 and 19 read in conjunction with Fig. 4.

The Office Action has applied the '541 reference to both the prior apparatus and device claims. These claims are now cancelled and claim 9 is directed to the method of the present invention wherein the sequential fitting of the balls to their raceways is specifically related in conjunction with the measuring of the torque and setting the torque to within a predetermined range. The '541 reference is silent concerning applying preload to the bearing disclosed and is directed to providing a bearing with extended life. Since claim 9 is directed to the method of preloading and the '541 reference is silent concerning this, it is respectfully submitted that the '541 reference cannot anticipate now pending claim 9.

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The Examiner states that the method of claims 5-8 would inherently result. The concept that a reference inherently discloses material anticipating a claimed invention may not be relied upon where the consequences of following the reference disclosure does not always inherently produce the results of the claimed invention. *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 314 (Fed. Cir. 1983). Since the '541 reference does not relate how preload is applied, one may simply have used a torque wrench on a nut applying preload to the bearings of the '541 reference to torque the nut to a predetermined torque without measuring rotation torque. Hence, it is respectfully submitted that the reference cannot be relied upon for inherently teaching the claimed method.

REQUEST FOR EXTENSION OF TIME

Applicants respectfully request one month extension of time for responding to the Office Action. Please charge the fee of \$130.00 for the extension of time to Deposit Account No. 10-1250.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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